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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,017	02/14/2001	Hiroshi Kamiya	Q63036	3808

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

THEIN, MARIA TERESA T

ART UNIT PAPER NUMBER

3627

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,017

Applicant(s)

KAMIYA, HIROSHI

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 22, 2005 has been entered.

Response to Amendment

Applicant's "Amendment" filed on February 22, 2005 has been considered.

Claims 1, 4, 7, and 10 are amended. New claims 13-32 are added. Claims 1-32 remain pending in this application.

The Examiner recommends the Applicant to change claim 10 to read "currently amended" not "currently presented".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,314,406 to O'Hagen et al. in view of U.S. Patent No. 4,926,325 to Benton et al.

Regarding claims 1, 4, 7, and 10, Sakai discloses a commodity order issuing and accepting method, system and apparatus comprising:

- providing an order issuing device of electronic communications (customer information terminal or portable transaction computer 14, col. 6, lines 51-58);
- providing an order accepting device capable of electronic communications (merchant's host computer 12, col. 6, lines 51-53);
- the requesting a first electronic document comprising first input fields for accepting order issuer information and for accepting commodity order issuance information except for an order issuer's payment date from the order accepting device (col. 15, lines 40-49; Figures 14-15; col. 16, lines 48-61; col. 17, lines 1-36);
- the transmitting the first electronic document from the order acceptor side to the order issuing device (col. 16, lines 16-20; col. 16, lines 23- 26; col. 17, lines 1-36);
- the inputting the order issuer information and the commodity order issuance information except for the order issuer's payment date to the first input fields on the order issuing device (col. 15, lines 40-49; col. 16, lines 48-61; col. 17, lines 1-36; Figures 16-17);

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- the transmitting the order issuer information and the commodity order issuance information except for the order issuers' payment date from the order issuer side to the order accepting device (col. 15, lines 40-49; col. 16, lines 16-20; col. 16, lines 23- 26; col. 17, lines 1-36; Figures 16-17);
- the retrieving a transaction condition corresponding to the commodity order issuance information on the order accepting device (col. 17, lines 37-56; Figure 18);
- the transmitting a second electronic document on which the transaction condition is described (Figures 19a-19b; col. 17, line 57 – col. 18, line 20).

However, O'Hagen does not explicitly disclose inputting the order issuer's payment date and transmitting the order issuer's payment date. O'Hagen does disclose that when a customer is shopping, he or she will pay the lower of the price the product is being offered at the store or the quoted price as long as the customer is in the time frame (col. 28, lines 45-48). When a customer shops, the products or items chosen by the customer are logged or recorded (col. 23, lines 41-42). The logged information include the product identification, the time the product was added to the list, the price, data relating to how long the price quote for the product will remain in effect, data relating to the time of purchase of the product, and data relating to what the customer paid for the product (Figure 32; col. 23, lines 42-52).

Benton, on the other hand, teaches the inputting the order issuer's payment date and transmitting the order issuer's (buyer) payment date (col. 9, lines 51-54; col. 16, lines 30-32; col. 16, lines 38-42). Benton teaches a system and method for carrying out

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funds data transfer between buyers and sellers in a common location, a local mode of operation, or at different locations in a remote mode (col. 2, lines 50-52; col. 2, lines 59-61). Benton further teaches the prompting of the buyer to enter the date and time of the proposed transaction (col. 16, lines 38-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, system, and apparatus of O'Hagen, to include the inputting and transmitting of the order issuer's payment date, as taught by Benton, in order to provide the buyer payment options (Benton col. 16, lines 30-33).

Regarding claims 2, 5, 8, and 11, O'Hagen discloses calculating a reduced price corresponding to the transaction condition (col. 21, lines 15-16; Figure 32; col. 23, lines 42-52; col. 28, lines 45-50; col. 32, lines 1-3).

Regarding claims 3, 6, 9, and 12, O'Hagen discloses transmitting a third electronic document on which the reduced price is described and which has means for inputting an authentication to said order issuing device; activating the means for inputting the authentication; and transmitting information representing that said means for inputting the authentication has been activated to said order accepting device (col. 17, lines 20-56; col. 28, lines 44-56).

Regarding claims 13-20, O'Hagen substantially discloses the claimed invention, however, it does not explicitly disclose the order issuer's payment date is a proposed payment date and is manually entered by a user. O'Hagen does disclose that when a customer is shopping, he or she will pay the lower of the price the product is being

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offered at the store or the quoted price as long as the customer is in the time frame (col. 28, lines 45-48). When a customer shops, the products or items chosen by the customer are logged or recorded (col. 23, lines 41-42). The logged information include the product identification, the time the product was added to the list, the price, data relating to how long the price quote for the product will remain in effect, data relating to the time of purchase of the product, and data relating to what the customer paid for the product (Figure 32; col. 23, lines 42-52).

Benton, on the other hand, teaches the order issuer's payment date is a proposed payment date and is manually entered by a user (col. 9, lines 51-54; col. 16, lines 30-32; col. 16, lines 38-42). Benton teaches a system and method for carrying out funds data transfer between buyers and sellers in a common location, a local mode of operation, or at different locations in a remote mode (col. 2, lines 50-52; col. 2, lines 59-61). Benton further teaches the buyer to elect to carry out the transaction immediately or prompting of the buyer to enter the date and time of the proposed transaction (col. 16, lines 38-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, system, and apparatus of O'Hagen, to include the order issuer's payment date is a proposed payment date and is manually entered by a user, as taught by Benton, in order to provide the buyer payment options (Benton col. 16, lines 30-33).

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Regarding claims 21-32, O'Hagen discloses HTML format (col. 7, lines 14-17), Internet (col. 3, lines 2-4), and a transaction condition is a formula related to a commodity transaction (Figures 18; 19a-19b; col. 17, lines 19-56).

Response to Arguments

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,859,414 to Grimes et al. discloses a customer information terminal for use in a retail grocery store.

U.S. Patent No. 6,352,201 to Novogrod discloses a system and method for requesting and dispensing negotiable instruments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
May 30, 2005

James S. McClellan
JAMES MCCLELLAN
PRIMARY EXAMINER